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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,800	06/27/2001	Robert Andrew Byers JR.	1535-001	9649

7590 03/31/2005

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EXAMINER

THEIN, MARIA TERESA T

ART UNIT PAPER NUMBER

3627

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,800

Applicant(s)

BYERS ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,8,9,15,16,18,19,21-30,32,33 and 35-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,8,9,15,16,18,19,21-30,32,33 and 35-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicants' "Amendment" filed on January 10, 2005 has been considered.

Applicants' response by virtue of amendment to claims 1-2, 5 and 8 has overcome the Examiner's rejection of such claims under 35 U.S.C. §101.

Applicants' response by virtue of amendment to claim 9 has not overcome the Examiner's rejection of such claims under 35 U.S.C. §101. Please see Office Action below.

Claims 1, 5, 8, 15, 18-19, 21-22, 29, 32-33, and 35-36 are amended. Claims 3-4, 6-7, 10-14, 17, 20, 31, and 34 are cancelled. Claims 1-2, 5, 8-9, 15-16, 18-19, 21-30, 32-33 and 35-42 remain pending in this application.

Claim Objections

Claim 8 is objected to because of the following informalities the claim depends on claim 6, which is canceled. For examination purposes, Examiner will assume claim 8 depends on claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 9 is rejected under 35 U.S.C. 101 because the method claims as presented do not claim a technological basis in the body of the claim.

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Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 9 has no connection to the technological arts. The phrase "receiving a signal" has no connection to the technological arts that enables a useful, concrete, tangible result. A signal per se is not the type of subject matter that is considered statutory. The "receiving a signal" is interpreted as an abstract arrangement that is transmitted or is a transmission in transit. Therefore, the claims are directed towards non-statutory subject matter. To overcome this rejection the Examiner recommends the Applicant to amend the claims to better clarify what is being performed to the computer.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 5, and 8-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1-2, 5, and 8-9 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The interaction with the seller computer, such as processing and transmitting the order information to the seller so that the order is delivered or shipped to the buyer, is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re*

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Mayhew, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). In the world of buying and selling of products over an electronic network, the seller and buyer must have bi-directional communication to do business. In claim 1, there is no such interaction between the buyer and seller because Applicants' have amended the preamble of the claim (claim 1) to have the transitional phrase "consisting of" which indicates the claim method to be close-ended and limits only the steps set forth in that claim. Since the buyer and only the buyer is performing all the steps without seller interaction, there is no selling and buying of products over the electronic network.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-2, 5, 8-9, the recitation "consisting of" render the claim indefinite. Applicant recites the term "consisting of" which is a closed transitional phrase. Applicant cannot add elements to a claim with a closed transitional phrase. See MPEP 2111.03.

Claims 21 and 35 recites the limitation "wherein said means for transmitting a user specific purchase history form" lack insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 5, 8-9, 15-16, 18-19, 21-30, 32-33 and 35-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,970,475 to Barnes in view of U.S. Patent Application Publication No. 2002/0065736 to Willner et al.

Regarding claim 1, Barnes discloses a method for selling products over an electronic network, the method consisting of the steps of:

identifying a user (see at least col. 6, lines 38-40; col. 6, lines 45-48);

transmitting a user specific order entry form (old requisition request, Figure 1), the order entry form comprising at least one user specific product, a user specific price for the at least one product and a quantity entry field (see at least col. 6, lines 54-65; col. 9, lines 33-35; col. 9, lines 51-54; col. 19, lines 56-58; Figure 11), wherein the user specific order entry form comprises a user specific purchase history form comprising all products that were purchased (Repeat from an old Requisition Request 133, Figure 11);

receiving a quantity of at least one product entered into the quantity entry field by the user (see at least col. 18, lines 42-44; col. 21, lines 48-50, Figure 11);

transmitting a shopping cart comprising each of the at least one product selected by the user (see at least col. 18, lines 45-54; col. 22, lines 46-54; Figure 11; and

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receiving an instruction from the user to process an order (see at least col. 22, lines 46-61; Figure 11).

However, Barnes does not explicitly disclose wherein the quantity entry field is the only field on the user specific order entry form in which entry of data by the user is required purchase the at least one product. Barnes discloses making a purchase and using a repeat from an old requisition request (Figure 11). The requisition request in Barnes is used as a purchase order to suppliers (col. 9, lines 33-34). The repeat from an old requisition request can be edited, which can include the quantity (Figure 11).

Willner, on the other hand, teaches the quantity entry field is the only field on the user specific order entry form in which entry of data by the user is required purchase the at least one product (Figure 6B; Figure 11; paragraph 20).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Barnes, to include the quantity entry field is the only field on the user specific order entry form in which entry of data by the user is required purchase the at least one product, as taught by Willner, in order to have an organize way of purchasing goods and services (Willner paragraph 9), thus providing an ordering method that is not a time-consuming process (paragraph 7).

Regarding claims 2-5, Barnes discloses the user specific entry form that further comprises an internal part number associated with at least one previously ordered product (see at least Ref. no. 133, Figure 11; col. 22, lines 48-49); and a user specific order entry form that further comprises at least one previously quoted product (see at least Figures 11-12; col. 22, lines 46-53).

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Regarding claims 8, Barnes substantially discloses the claimed invention, however, Barnes does not disclose purchasing form comprises a total of the at least one previously ordered product that was purchased during the specified time period.

Barnes discloses all users can view status and history of orders and generate reports (see at least Figures 11-12; col. 22, lines 46-53). Furthermore, Barnes discloses the Bank server can provide various reports on Customer transactions, where all ACH transactions have a full event history (see at least col. 18, lines 23-30). Moreover, Barnes discloses the customer or buyer has access to select audit existing reports or access "user-defined reports" at which the user can define in a format that is useful to the user (see at least col. 23, lines 43-48). Willner, on the other hand, teaches the total of the at least one previously ordered product that was purchased during the specified time period (paragraphs 58-59; paragraph 70).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Barnes to include the total of the at least one previously ordered product that was purchased during the specified time period, as taught by Willner, in order to have an organize way of purchasing goods and services (Willner paragraph 9), thus providing an ordering method that is not a time-consuming process (paragraph 7).

Regarding claim 9, Barnes discloses an icon having a link to a product information order entry form (see at least col. 22, line 46-col. 23, line 22; Figures 9, 11-13).

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Regarding claim 15, Barnes discloses a computer program product for selling products over an electronic network, the computer program product comprising:

means for identifying a user (see at least col. 6, lines 38-40; col. 6, lines 45-48);

means for transmitting a user specific order entry form (old requisition request, Figure 1), the order entry form comprising at least one user specific product, a user specific price for the at least one product and a quantity entry field (see at least col. 6, lines 54-65; col. 9, lines 33-35; col. 9, lines 51-54; col. 19, lines 56-58; Figure 11), wherein the user specific order entry form comprises a user specific purchase history form comprising all products that were purchased during a specified time period (Repeat from an old Requisition Request 133, Figure 11);

means for receiving a quantity of at least one product entered into the quantity entry field by the user (see at least col. 18, lines 42-44; col. 21, lines 48-50, Figure 11);

means for transmitting a shopping cart comprising each of the at least one product selected by the user (see at least col. 18, lines 45-54; col. 22, lines 46-54; Figure 11; and

means for receiving an instruction from the user to process an order (see at least col. 22, lines 46-61; Figure 11).

However, Barnes does not explicitly disclose wherein the specified time period and the quantity entry field is the only field on the user specific order entry form in which entry of data by the user is required purchase the at least one product. Barnes discloses making a purchase and using a repeat from an old requisition request (Figure 11). The requisition request in Barnes is used as a purchase order to suppliers (col. 9,

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lines 33-34). The repeat from an old requisition request can be edited, which can include the quantity (Figure 11).

Willner, on the other hand, teaches the specified time period and the quantity entry field is the only field on the user specific order entry form in which entry of data by the user is required purchase the at least one product (Figure 6B; Figure 11; paragraph 20; paragraph 59; paragraph 70).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the computer program product of Barnes, to include the quantity entry field is the only field on the user specific order entry form in which entry of data by the user is required purchase the at least one product, as taught by Willner, in order to have an organized way of purchasing goods and services (Willner paragraph 9), thus providing an ordering method that is not a time-consuming process (paragraph 7).

Regarding claims 16 and 18-19, Barnes discloses the user specific entry form that further comprises an internal part number associated with at least one previously ordered product (see at least Ref. no. 133, Figure 11; col. 22, lines 48-49); transmitting a user specific order template that further comprises a new product entry field (see at least Figures 11-12; col. 22, lines 46-53); and a user specific order template, the order template further comprising at least one previously quoted product (see at least Figures 11-12; col. 22, lines 46-53).

Regarding claims 21-22, Barnes substantially discloses the claimed invention, however, Barnes does not disclose means for displaying a date range form; means for receiving a data entered into the said data entry field by the user; and a total of the at

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least one previously ordered product that was purchased during the specified time period.

Barnes discloses a repeat old requisition request (Figure 11). Furthermore, Barnes discloses all users can view status and history of orders and generate reports (see at least Figures 11-12; col. 22, lines 46-53). Moreover, Barnes discloses the customer or buyer has access to select audit existing reports or access "user-defined reports" at which the user can define in a format that is useful to the user (see at least col. 23, lines 43-48). Willner, on the other hand, teaches means for displaying a date range form; means for receiving a data entered into the said data entry field by the user; and the total of the at least one previously ordered product that was purchased during the specified time period (paragraphs 58-59; paragraph 70).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Barnes to include the date range form; means for receiving a data entered; and the total of the at least one previously ordered product that was purchased during the specified time period, as taught by Willner, in order to have an organize way of purchasing goods and services (Willner paragraph 9), thus providing an ordering method that is not a time-consuming process (paragraph 7).

Regarding claims 23-25, Barnes discloses an icon having a link to a product information order entry form; an icon having a link to a peer review form; and an icon having a link to a product protocol form (see at least col. 22, line 46-col. 23, line 22; Figures 9, 11-13).

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Regarding claims 26-28, Barnes discloses sort filed; transmitting a payment option form and receiving an instruction from the user to utilize a specified payment option; and transmitting a facility option form and receiving an instruction from the user to utilized a specified facility option (see at least col. 8, lines 36-61; col. 18, lines 42-55; col. 23, lines 36-43; col. 25, lines 26-40).

Regarding claims 29-30 and 32-33, the claims recite a system that are parallel in scope to claims 15-16 and 18-19 above and are rejected under similar grounds.

Regarding claims 35-36, the claims recite a system that are parallel in scope to claims 21-22 above and are rejected under similar grounds.

Regarding claims 37-42, the claims recite a system that are parallel in scope to claims 23-28 above and are rejected under similar grounds.

Response to Arguments

Applicants' arguments with respect to claims 1, 5, 8, 15, 18-19, 21-22, 29, 32-33, and 35-36 have been considered but are moot in view of the new ground(s) of rejection.

Applicants remark that "Barnes reference cannot anticipate claim 1", specifically, the recitation of "only the quantity of a product to be entered into the order entry form to purchase that product" and "a user specific purchase history form comprising all products that were purchased during a specified time period".

The Examiner draws Applicants attention to the Office Action above.

Applicants remark that "neither Barnes reference, the Johnson reference, or the other references cited provide an order entry form that displays a purchase history form

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which a user can view all products purchased over a specified period of time, and allows a user to directly place orders using this purchase history”.

The Examiner does not concur. Barnes discloses making a purchase and using a repeat from an old requisition request (Figure 11). The requisition request in Barnes is used as a purchase order to suppliers (col. 9, lines 33-34). The repeat from an old requisition request can be edited, which can include the quantity (Figure 11). Such repeat from an old requisition request is considered an order entry form that displays a purchase history form which a user can view all products purchased and allows a user to directly place orders using this purchase history. For the recitation of “the specified time period”, the Examiner draws Applicants’ attention to the Office Action above.

Conclusion

Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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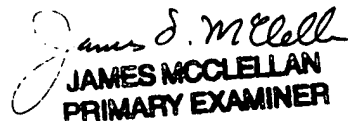
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
March 24, 2005


JAMES MCCLELLAN
PRIMARY EXAMINER